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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/772,944

02/05/2004

John E. Kast

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IPLM GROUP, P.A.

POST OFFICE BOX 18455

MINNEAPOLIS, MN 55418

EXAMINER

OROPEZA, FRANCES P

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/772,944	Applicant(s) KAST ET AL.	
	Examiner FRANCES P. OROPEZA	Art Unit 3766	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/15/07 (Amendment).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgement

1. Mr. Carl Layno was the Examiner previously assigned to this case. Mr. Layno was promoted to a supervisory position in the U.S. Patent and Trademark Office. Since this case was in mid-prosecution at the time of Mr. Layno's reassignment, it has been assigned to a new Examiner. The current Examiner acknowledges the Applicant's response of 10/15/07. The Applicant amended the claims, hence this Office action is made Final. The Applicant's comments in the response filed 10/15/07 have been fully considered and are convincing, hence a new rejection is established in the subsequent paragraphs.

Double Patenting

2. Claim 22 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 16 of prior U.S. Patent No. 6,505,077. This is a double patenting rejection. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225

USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 22 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 16 of U.S. Patent No. 6,505,077. Although the conflicting claims are not identical, they are not patentably distinct from each other because electronics to provide medical therapy are accepted to have a stimulation feed-through so the electrodes can be attached to the tissue of the patient, and hermetic sealing of implanted devices is inherent to prevent the body fluids from attacking at least the electronics of the implanted device.

Claim Rejections - 35 USC § 103

4. Claims 1-17 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leysieffer (U.S. Patent No. 6,154,677).

As related to claims 1 and 2, Leysieffer substantially discloses the instant invention comprising an implantable medical device (54) adapted to be charged with an external recharging coil (106), the device comprising a housing (72) having an interior cavity, a proximal face, and an electrical feedthrough, the hermetically sealed penetrations (108) are read as electrical/ recharge feed-through (col. 4 @ 56-60) on the proximal face, electronics carried in the housing interior cavity, the electronics configured to perform a medical therapy (74), a rechargeable power source (90) carried in the housing interior cavity and electrically coupled to the electronics; and, a recharging coil (106) electrically coupled through the housing electrical feed-through (108) to the electronics and rechargeable power source (90) (Figures 1, 5; col. 4 @ 14-60).

As related to the recharging coil being centrally located and substantially carried on the housing proximal face, Leysieffer discloses the recharging coil is located on at least a part of the broad side of the housing (col. 7 @ 44-46). Absent any teachings of criticality or unexpected results, merely changing the location of the coil on the exterior face of the housing to a central location would be an obvious design choice. (Instant application, page 2, lines 15-18 - “the recharging coil can either be carried on the proximal face... or detached ... and located remotely”)

As relate to claims 3, 5, 8 and 10-13, the coil is connected mechanically tightly to the housing using polymer jacketing (104), read as the coil cover, and polymer over-molding, read as a means for attaching the recharge coil to the housing (col. 4 @ 42-53; col. 7 @ 20-23).

As related to claims 4, 6, 7 and 9, alignment details (poles) and attachment details are provided for the housing and coil cover (104) (col. 4 @ 14-19).

As related to claims 14, 15 and 18, the polymer jacketing is read as a retention sleeve that is hermetically sealed to the housing (col. 6 @ 2-4; col. 7 @ 20-23 and 27-28).

As related to claims 16 and 17, the power source is a rechargeable electrochemical battery (col. 4 @ 20-24).

As related to claim 19, the receiving coil can be used for telemetry (col. 6 @ 51-57).

As related to claim 20, the implanted medical device is a pacemaker (col. 2 @ 10).

As related to claim 21, Leysieffer substantially discloses the instant invention comprising an implantable medical device (54) adapted to be charged with an external recharging coil (106), the device comprising a housing (72) having an interior cavity, a proximal face, and an electrical feed-through, the hermetically sealed penetrations (108) are read as electrical/ recharge feed-through (col. 4 @ 56-60) on the proximal face, electronics carried in the housing interior cavity, the electronics configured to perform a medical therapy (74), a rechargeable power source (90) carried in the housing interior cavity and electrically coupled to the electronics; a means for recharging, a recharging coil (106), electrically coupled through the housing electrical feed-through (108) to the electronics and rechargeable power source (90) (Figures 1, 5; col. 4 @ 14-60).

As related to the recharging coil being centrally located and substantially carried on the housing proximal face, Leysieffer discloses the recharging coil is located on at least a part of the broad side of the housing (col. 7 @ 44-46). Absent any teachings of criticality or unexpected

results, merely changing the location of the coil on the exterior face of the housing to a central location would be an obvious design choice. (Instant application, page 2, lines 15-18 - “the recharging coil can either be carried on the proximal face... or detached ... and located remotely”)

As related to the means for attaching the means for recharging, Leysieffer discloses the coil is attached to the housing using alignment details (poles) and attachment details (col. 4 @ 14-19) and the coil is connected mechanically tightly to the housing using polymer jacketing (104) and polymer over-molding, read as a means for attaching the recharge coil to the housing (col. 4 @ 42-53; col. 7 @ 20-23).

As related to claim 22, Leysieffer substantially discloses the instant invention comprising an implantable medical device (54) adapted to be charged with an external recharging coil (106), the device comprising a housing (72) having an interior cavity, a proximal face, and an electrical feed-through, the hermetically sealed penetrations (108) are read as electrical/ recharge feed-through (col. 4 @ 56-60) on the proximal face, electronics carried in the housing interior cavity, the electronics configured to perform a medical therapy (74), a rechargeable power source (90) carried in the housing interior cavity and electrically coupled to the electronics; a means for recharging, a recharging coil (106), electrically coupled through the housing electrical feed-through (108) to the electronics and rechargeable power source (90) (Figures 1, 5; col. 4 @ 14-60).

As related to the recharging coil being carried on the housing proximal face, Leysieffer discloses the recharging coil is located on at least a part of the broad side of the housing

(col. 7 @ 44-46). Absent any teachings of criticality or unexpected results, merely changing the location of the coil on the exterior face of the housing to the housing proximal face would be an obvious design choice. (Instant application, page 2, lines 15-18 - “the recharging coil can either be carried on the proximal face... or detached ... and located remotely”)

As related to the alignment and attachment details, Leysieffer discloses the coil is attached to the housing using alignment details (poles) and attachment details (col. 4 @ 14-19).

5. Claim 18 rejected under 35 U.S.C. 103(a) as being unpatentable over Leysieffer (US 6154677) in view of Baumann et al. (US 5279292).

As discussed in paragraph 4 of this action, Leysieffer discloses the claimed invention except for locating a telemetry coil in the interior cavity of the housing.

Baumann et al. teach an implantable device charging evaluation system using a telemetry circuit and associated coil mounted in the housing to provide information on the alignment of the transmitting coil relative to the receiving coil and/or on the charging state of the direct voltage source (col. 2 @ 5-10). It would have been obvious to one having ordinary skill in the art at the time of the invention to have used a telemetry coil and associated coil mounted in the housing in the Leysieffer system to optimize the efficiency and effectiveness of the recharging process and to ensure adequate power is maintain for successful operation of the device.

Statutory Basis

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fran Oropeza whose telephone number is (571) 272-4953. Fran's schedule typically is Monday and Tuesday 9AM-7PM EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl H. Layno can be reached on (571) 272-4949. Carl's schedule typically is Monday, Wednesday, Friday 9AM-5 PM EST; Tuesday, Thursday 9AM-3PM and 9PM-11PM EST. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communication and for After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Frances P. Oropeza/

Patent Examiner, Art Unit 3766

/Carl H. Layno/

Supervisory Patent Examiner, Art Unit 3766